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JGJr: 0104

Paper No: 29

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**JAN 29 2004**

**OFFICE OF PETITIONS**

In re Application of:	:	ON PETITION
Shetty, et al.	:	
Filed: 12 June, 2000	:	
Application No. 09/486,125	:	
Docket No.: 10546-010	:	

This is a decision on the petition filed herein on 14 October, 2003, under 37 C.F.R. §1.181 to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition under 37 C.F.R. §1.181 is **DISMISSED**.

BACKGROUND

The record indicates that:

- Petitioner failed to reply timely and properly to the final Office action mailed on 13 November, 2002, and due under a non-extendable deadline on or before 13 February, 2003;
- the application was deemed abandoned after midnight 13 February, 2003;
- Notice of Abandonment was mailed on 6 June, 2003;
- on 31 July, 2003, Petitioner filed a petition (with fee) under 37 C.F.R. §1.137(a), alleging unavoidable delay and that he was unaware of the final Office action, and an after-final amendment that did not prima facie place the application in condition for allowance, rather than a proper reply (e.g., a Notice of Appeal or a Request for Continued Examination (RCE) under 37 C.F.R. §1.114, see: the commentary at MPEP §711.03(c));
- due to the non-receipt allegation, the petition was considered under 37 C.F.R. §1.181;

- on 8 August, 2003, the petition was dismissed for failure to satisfy regulatory requirements;
- Petitioner now seeks to support an allegation under 37 C.F.R. §1.181 and also files what he styles as a "Contingent" RCE (with fee authorization) and submission in the form of an Amendment.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>4</sup> See: *In re Application of G.*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

Allegations as to the Request to Withdraw  
the Holding of Abandonment

Petitioner failed to file and support a petition under 37 C.F.R. §1.181 within two (2) months of the action complained of and, having gone beyond that time period, failed to submit a terminal disclaimer. (See: MPEP §711.03(c)(I).) Petitioner attempts to overcome this deficiency by responding that the Office considered his original petition in light of 37 C.F.R. §1.181. However, the duties imposed by statute, regulation and case law are active, not passive, ones. The burden is upon the Petitioner to do—not upon the Office to divine Petitioner’s intent.

Moreover, Petitioner’s failure to file with a petition under 37 C.F.R. §1.137(a) a proper reply to a final Office action (i.e., a Notice of Appeal (with fee), an RCE (with fee and submission) or an amendment *prima facie* placing the application in condition for allowance) does not evidence one’s duty of diligence.

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>7</sup>

Petitioner’s failure to plead and support timely the petition under 37 C.F.R. §1.181 precludes a grant of that petition now.

CONCLUSION

Petitioner failed to satisfy the burdens set forth in Delgar v. Schulyer, and so the petition under 37 C.F.R. §1.181 must be and hereby is **dismissed**.

The instant application will be held in the Office of Petitions to consider an alternative pleading by Petitioner.

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<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one’s attention and the mail is not timely deposited for shipment.

<sup>7</sup> See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read 'J. Gillon', with a stylized flourish at the end.

John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions